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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,465	03/23/2004	Takahiro Kitajima	492322017200	1695

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EXAMINER

CHANG, RICK KILTAE

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,465

Applicant(s)

KITAJIMA ET AL.

Examiner

Rick K. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a feeding device, classified in class 221, subclass 73.
 - II. Claims 8-19, drawn to a mounting apparatus, classified in class 29, subclass 740.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group II and of Group I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination is not adjustable for the pitches of the components. The subcombination has separate utility such as dispensing pills with different sizes with varying pitches to a patient.
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. If the applicant elected Group II, the applicant is required to elect one of the following distinct species of the claimed invention, as disclosed below since Group II contain claims directed to the following patentably distinct species of the claimed invention:

Species 1: an automatic electronic component mounting apparatus that does not require an operator and an image display device, claims 8-13.

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Species 2: a semiautomatic electronic component mounting apparatus requiring an operator and an image display device, claims 14-19.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. If the applicants elected Species 1, Restriction to one of the following inventions is required under 35 U.S.C. 121:

- a. Claim 9, drawn to a feeding device, classified in class 221, subclass 73.
- b. Claims 10-11, drawn to a control device, classified in class 29, subclass 709.
- c. Claim 12, drawn to a mounting apparatus, classified in class 29, subclass 740.
- d. Claim 13, drawn to a camera, classified in class 29, subclass 720.

6. The inventions are distinct, each from the other because of the following reasons:

7. Claim 8 links the inventions Groups a-d. The restriction requirement of the linked inventions is subject to the nonallowance of the linking claim, claim 8. Upon the allowance of

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the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 f.2d 1211, 1275, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

8. Inventions of Group a, of Group b, of Group c and of Group d are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, Group a does not require a control device, a mounting head and a camera; Group b does not require a component feeding device, a mounting head and a camera; Group c does not require a component feeding device, a control device and a camera; and Group d does not require a control device, a mounting head and a component feeding device.

9. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

10. If the applicant elected Group b, the applicant is required to elect one of the following distinct species of the claimed invention, as disclosed below since Group b contain claims directed to the following patentably distinct species of the claimed invention:

Species a: Figs. 10A-10B, drawn to claim 10.

Species b: Figs. 12A-12B, drawn to claim 11.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

11. If the applicants elected Species 2, Restriction to one of the following inventions is required under 35 U.S.C. 121:

- e. Claim 15, drawn to a feeding device, classified in class 221, subclass 73.
- f. Claims 16-17, drawn to a control device, classified in class 29, subclass 709.
- g. Claim 18, drawn to a mounting apparatus, classified in class 29, subclass 740.
- h. Claim 19, drawn to a camera, classified in class 29, subclass 720.

12. The inventions are distinct, each from the other because of the following reasons:

13. Claim 14 links the inventions Groups e-h. The restriction requirement of the linked inventions is subject to the nonallowance of the linking claims, claim 14. Upon the allowance of

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the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 f.2d 1211, 1275, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

14. Inventions of Group e, of Group f, of Group g and of Group h are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, Group e does not require a control device, a mounting head and a camera; Group f does not require a component feeding device, a mounting head and a camera; Group g does not require a component feeding device, a control device and a camera; and Group h does not require a control device, a mounting head and a component feeding device.

15. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

16. If the applicant elected Group f, the applicant is required to elect one of the following distinct species of the claimed invention, as disclosed below since Group 2 contain claims directed to the following patentably distinct species of the claimed invention:

Species aa: Figs. 10A-10B, drawn to claim 16.

Species bb: Figs. 12A-12B, drawn to claim 17.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

17. Due to the complex nature of the restriction and election of species requirements, no telephone call was made to the attorney of record to request an oral election to the above requirement.

18. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

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19. Please provide reference numerals (either in parentheses next to the claimed limitation or in a table format with one column listing the claimed limitation and another column listing corresponding reference numerals in the remark section of the response to the Office Action) to all the claimed limitations as well as support in the disclosure for better clarity (optional). Applicants are duly reminded that a full and proper response to this Office Action that includes any amendment to the claims and specification of the application as originally filed requires that the applicant point out the support for any amendment made to the disclosure, including the claims. See 37 CFR 1.111 and MPEP 2163.06.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick K. Chang whose telephone number is (571) 272-4564. The examiner can normally be reached on 5:30 AM to 1:30 PM, Monday through Thursday.

The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.



RICHARD CHANG
PRIMARY EXAMINER

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RC

May 17, 2006